

REMARKS

Claims 1-19 were pending in the application. Claims 1-9, 12-19 have been cancelled without prejudice to presentation in future related applications. Claims 10 and 11 have been amended. New claims 20-38 have been added.

The claims were amended to remove reference to non-elected inventions and to further clarify the claimed invention. Applicants note that the elected invention includes SEQ ID NOS:1174 (genomic) and 1175 (mRNA). Table 1 (filed with the present application (see attached transmittal)) lists sequences relating to the gene referred to as "06-0196". As set forth on page 24 of the published application and as set forth in Table 1, these sequences correspond to hCG21264. Applicants attach a printout from the NCBI Sequence Viewer which sets forth that hCG21264 corresponds to human sialophorin. Accordingly, Applicants assert that the inclusion of the name of the claimed gene does not constitute new matter.

Support for the amendments to claims 10 and 11 and for new claims 20-38 can be found throughout the application as originally filed, including, for example, in the as-filed claims, Tables 1 and 9, and paragraphs [0008], [0009], [0020]-[0022], [0024], [0033], [0048], [0124], [0125], [0141], [0167] and [0222].¹

No new matter has been added.

Upon entry of this amendment, claims 10, 11 and 20-38 will be pending.

Restriction Requirement

Pending claims 1-19 are subject to a restriction requirement. The Examiner required Applicants to elect one of eleven allegedly patentably distinct inventions for examination. The Office also required the election of one sequence for examination, noting that if an invention is elected that reads on a nucleic acid, the genomic sequence and its mRNA will be searched. Applicants respectfully traverse on the grounds that searching more than one of the groups set forth by the Office would pose no serious burden on the Examiner.

¹ Paragraph numbering is as set forth in United States Patent Application Publication 20020182586A1.

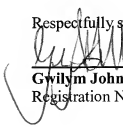
MPEP §803 sets forth criteria for determining when restriction is proper, stating, inter alia, that “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” Applicant respectfully asserts that searching more than group would not constitute a serious burden. Although Applicants respectfully traverse the restriction requirement on the grounds that examining more than one invention would not constitute a serious burden, Applicants provisionally elect herein “Group V, Claims 10 and 11, drawn to a method for evaluating the effect of a candidate carcinoma drug comprising administering said drug to a patient, removing a cell sample and determining alterations in the expression or activation of a gene comprising a nucleic acid sequence (06001 to 06-343) consisting of a sequence outlined in Table 1, respectively, classified in class 436, subclass 63”. As amended, claims 10 and 11 and new claims 20-38 read on elected Group V.

Applicants reserve the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

Conclusion

The examination of the pending claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicant invites the Examiner to contact the undersigned at (302) 778-8458 to clarify any unresolved issues raised by this response.

Respectfully submitted,



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(302) 652-5070 telephone
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

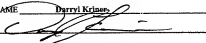
Docket No. A-71363/RMS/DCF

Anticipated Classification of
this Application:

Class: Subclass:

Prior Application:

Examiner:
Art Unit: 1645

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TYPED NAME Darri Krizan
SIGNED 

Box PATENT APPLICATION
Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This is a request for filing an

- ☐ Original
- ☐ Continuation
- ☐ Divisional
- ☒ Continuation-in-part

application under 37 C.F.R. 1.53(b), in the name of David MORRIS and Eric ENGELHARD, for
NOVEL COMPOSITIONS AND METHODS FOR CANCER.

1. (a) ☐ Enclosed is a new application.
(b) ☒ Enclosed is a continuation-in-part application.
(c) ☐ Enclosed is a copy of the prior application.
2. (a) ☐ Enclosed is a new Declaration.
(b) ☐ Enclosed is a copy of the prior executed Declaration as originally filed.
(c) ☐ Enclosed is a Combined Declaration/Power of Attorney.

3. (a) ☐ Enclosed is a Small Entity Affidavit.
 (b) ☒ A Small Entity Affidavit is of record in the prior application.

4. ☐ The filing fee is calculated below:

Claims as filed in the prior application, less any claims canceled by amendment below:

	(Col. 1)	(Col.2)	<u>SMALL ENTITY</u>			<u>OTHER THAN A SMALL ENTITY</u>	
For:	<u>No. Filed</u>	<u>No. Extra</u>	<u>Rate</u>	<u>Fee</u>	<u>Or</u>	<u>Rate</u>	<u>Fee</u>
Basic Fee				\$ 370.00			\$740.00
Total Claims	<u>19</u> - 20 =	<u>0</u>	<u>0</u> x 9 =	<u>\$.00</u>	OR	<u> </u> x \$18 =	<u>\$</u>
Indep Claims	<u>14</u> - 3 =	<u>11</u>	<u>11</u> x 42 =	<u>\$ 154.00</u>	OR	<u> </u> x \$84 =	<u>\$</u>
[] Multiple Dependent Claims			+ \$140 =	<u>\$.00</u>	OR	+ \$280 =	<u>\$</u>
Total				<u>\$ 524.00</u>			<u>\$</u>


* If the difference in Col. 1 is less than zero, enter "0" in Col. 2.

5. ☒ NO check is enclosed.
6. ☐ Our check in the amount of _____ is enclosed.
7. ☐ The Commissioner is hereby authorized to charge any additional fees which may be required, including extension fees, or credit any overpayment to Deposit Account No. 06-1300 (Order No. A-71363/RMS/DCF).
8. ☐ Cancel in this application original claims _____ of the prior application before calculating the filing fee. (At least one independent claim must be retained for filing purposes.)
9. ☐ Amend the specification by inserting before the first line the sentence:

10. (a) ☐ Informal drawings are enclosed, ☐ sheets.
(b) ☐ Formal drawings are enclosed, ☐ sheets.
11. (a) ☒ Claims benefit of U.S. Applications Serial Nos. 09/747,377, filed December 22, 2000, and 09/798,586, filed March 2, 2001.
(b) ☐ The certified copy has been filed in prior application Serial No. filed on .
12. ☐ An Assignment is enclosed.
13. ☐ The prior application is assigned of record to .
14. ☐ A Power of Attorney by Assignee is enclosed.
15. ☒ The power of attorney in the prior application is to:
FLEHR HOHBACH TEST ALBRITTON & HERBERT, LLP
(a) ☐ The power appears in the original papers in the prior application.
(b) ☐ Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.
(c) ☒ Address all future communications to:
Robin M. Silva, Esq.
FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP
Suite 3400, Four Embarcadero Center
San Francisco, California 94111-4187
Telephone: (415) 781-1989
16. ☐ A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)
17. ☐ A Prior Art Statement is enclosed.

18. ____ A Sequence Listing is enclosed (comprising a communication, computer readable sequence listing, and paper copy thereof).
19. X A CD-ROM (in duplicate) is enclosed which contains Table 1 which is a table of sequences. These sequences are expressly incorporated into the specification by reference.
20. ____ I hereby verify that the attached papers are a true duplicate of prior application Serial No. ____
____ as originally filed on ____.

Date: 2/1/02



David C. Foster, Reg. No. 44,685
Patent Agent for
Robin M. Silva, Reg. No. 38,304

Address of Signer:

X Attorney or agent of record

Suite 3400, Four Embarcadero Center
San Francisco, California 94111-4187
Telephone: 415-781-1989

____ Filed under Section 1.34(a)

1076384

ACCESSION #: 06-196
 CANCER GENE: mCG22397/hCG21624

MOUSE GENOMIC SEQUENCE (mCG22397)

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HUMAN PROTEIN SEQUENCE (hCP1690086)

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Range: from **begin** to **end** Features:

☐ **1:** [EAW80015](#). Reports **sialophorin (gpL1...[gi:119600421]**

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DEFINITION sialophorin (gpL115, leukosialin, CD43), isoform CRA_a [Homo sapiens].
ACCESSION EAW80015
VERSION EAW80015.1 GI:119600421
DBSOURCE accession [CH471238.1](#)
KEYWORDS .
SOURCE Homo sapiens (human)
ORGANISM Homo sapiens
 Eukaryota; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi; Mammalia; Eutheria; Euarchontoglires; Primates; Haplorrhini; Catarrhini; Hominidae; Homo.
REFERENCE 1 (residues 1 to 400)
AUTHORS Venter, J.C., Adams, M.D., Myers, E.W., Li, P.W., Mural, R.J., Sutton, G.G., Smith, H.O., Yandell, M., Evans, C.A., Holt, R.A., Gocayne, J.D., Amanatides, P., Ballew, R.M., Huse, D.H., Wortman, J.R., Zhang, Q., Kodira, C.D., Zheng, X.H., Chen, L., Skupski, M., Subramanian, G., Thomas, P.D., Zhang, J., Gabor Miklos, G.L., Nelson, C., Broder, S., Clark, A.G., Nadeau, J., McKusick, V.A., Zinder, N., Levine, A.J., Roberts, R.J., Simon, M., Slayman, C., Hunkapiller, M., Bolanos, R., Delcher, A., Dew, I., Fasulo, D., Flanagan, M., Florea, L., Halpern, A., Hannenhalli, S., Kravitz, S., Levy, S., Mobarry, C., Reinert, K., Remington, K., Abu-Threideh, J., Beasley, E., Biddick, K., Bonazzi, V., Brandon, R., Cargill, M., Chandramouliswaran, I., Charlab, R., Chaturvedi, K., Deng, Z., Di Francesco, V., Dunn, P., Eilbeck, K., Evangelista, C., Gabriellian, A.E., Gan, W., Ge, W., Gong, F., Gu, Z., Guan, P., Heiman, T.J., Higgins, M.E., Ji, R.R., Ke, Z., Ketchum, K.A., Lai, Z., Lei, Y., Li, Z., Li, J., Liang, Y., Lin, X., Lu, F., Merkulov, G.V., Milshina, N., Moore, H.M., Naik, A.K., Narayan, V.A., Neelam, B., Nusskern, D., Rusch, D.B., Salzberg, S., Shao, W., Shue, B., Sun, J., Wang, Z., Wang, A., Wang, X., Wang, J., Wei, M., Wides, R., Xiao, C., Yan, C., Yao, A., Ye, J., Zhan, M., Zhang, W., Zhang, H., Zhao, Q., Zheng, L., Zhong, F., Zhong, W., Zhu, S., Zhao, S., Gilbert, D., Baumhueter, S., Spier, G., Carter, C., Cravchik, A., Woodage, T., Ali, F., An, H., Awe, A., Baldwin, D., Baden, H., Barnstead, M., Barrow, I., Beeson, K., Busam, D., Carver, A., Center, A., Cheng, M.L., Curry, L., Danaher, S., Davenport, L., Desilets, R., Dietz, S., Dodson, K., Dou, L., Ferrier, S., Garg, N., Gluecksmann, A., Hart, B., Haynes, J., Haynes, C., Heiner, C., Hladun, S., Hustin, D., Houck, J., Howland, T., Ibegwam, C., Johnson, J., Kalush, F., Kline, L., Koduru, S., Love, A., Mann, F., May, D., McCawley, S., McIntosh, T., McMullen, I., Moy, M., Moy, L., Murphy, B., Nelson, K., Pfannkuch, C., Pratts, E., Puri, V., Qureshi, H.,

Reardon,M., Rodriguez,R., Rogers,Y.H., Romblad,D., Ruhfel,B.,
 Scott,R., Sitter,C., Smallwood,M., Stewart,E., Strong,R., Suh,E.,
 Thomas,R., Tint,N.N., Tse,S., Vech,C., Wang,G., Wetter,J.,
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 Zhu,X.

TITLE The sequence of the human genome
 JOURNAL Science 291 (5507), 1304-1351 (2001)
 PUBMED [11181995](#)
 REFERENCE 2 (residues 1 to 400)
 AUTHORS Mural,R.J., Istrail,S., Sutton,G., Florea,L., Halpern,A.L.,
 Mobarry,C.M., Lippert,R., Walenz,B., Shatkay,H., Dew,I.,
 Miller,J.R., Flanagan,M.J., Edwards,N.J., Bolanos,R., Fasulo,D.,
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 Nusskern,D.R., Shue,B.C., Zheng,X.H., Zhong,F., Delcher,A.L.,
 Huson,D.H., Kravitz,S.A., Mouchard,L., Reinert,K., Remington,K.A.,
 Clark,A.G., Waterman,M.S., Eichler,E.E., Adams,M.D.,
 Hunkapiller,M.W., Myers,E.W. and Venter,J.C.
 TITLE Direct Submission
 JOURNAL Submitted (05-JUL-2005) Celera Genomics, 45 W. Gude Dr., Rockville,
 MD 20850, USA
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